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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/644,371

08/23/2000

George E. Smith

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06/17/2004

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PATENT-SEA

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EXAMINER

MEREK, JOSEPH C

ART UNIT

PAPER NUMBER

3727

DATE MAILED: 06/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/644,371

Applicant(s)

SMITH, GEORGE E.

Examiner

Joseph C. Merek

Art Unit

3727

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2003.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,4-7,10-12,19,21,22,26 and 73-83 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 2,4-7,10-12,19,21,22,26 and 73-83 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2, 4, 5, 6, 7, 10-12, 19, 21, 22, 26, and 73-83 are rejected under 35

U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding claim 73, it has not been adequately disclosed that "the background material being configured so that the entire first surface of the background material in the base portion and in the first region of the wall portion is visible through the second region of the wall portion from the exterior region". Regarding claim 74, it has not been adequately disclosed that "the background material being configured so that at least approximately the entire first surface of the background material in the base portion and in the first region of the wall portion is visible through the second region of the wall portion from the exterior region". Regarding claim 75, it has not been adequately disclosed that "the background material being positioned in the first region at a first distance spaced apart from the base portion and being absent from the second region at a second distance spaced apart from the base portion, the second distance being at least approximately equal to the first distance". Regarding claim 5, and 78, it

Art Unit: 3727

has not been adequately disclosed that the background that is between the inner and outer surface of the wall portion or the base portion (see Fig. 3C of the instant invention) also includes a protective layer. See the specification of the instant invention on page 8, lines 25-26, where it is stated that there is no need for a protective coating. These are new matter rejections. The remaining claims are included since they stem from rejected claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 4, 5, 6, 7, 10-12, 19, 21, 22, 26, and 73-83 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 73, it has not been adequately disclosed that "the background material being configured so that the entire first surface of the background material in the base portion and in the first region of the wall portion is visible through the second region of the wall portion from the exterior region". It is not clear what structure is required to satisfy this limitation. It is not clear what is being claimed. Regarding claim 74, it has not been adequately disclosed that "the background material being configured so that at least approximately the entire first surface of the background material in the base portion and in the first region of the wall portion is visible through the second region of the wall portion from the exterior region". It is not clear what structure is required to

Art Unit: 3727

satisfy this limitation. It is not clear what is being claimed. Regarding claim 75, it has not been adequately disclosed that "the background material being positioned in the first region at a first distance spaced apart from the base portion and being absent from the second region at a second distance spaced apart from the base portion, the second distance being at least approximately equal to the first distance". It is not clear what structure is required to satisfy this limitation. It is not clear what is being claimed.

Regarding claims 5, and 78, it has not been adequately disclosed that the background that is between the inner and outer surface of the wall portion or the base portion (see Fig. 3C of the instant invention) also includes a protective layer. See the specification of the instant invention on page 8, lines 25-26, where it is stated that there is no need for a protective coating. It is not clear what structure is required to satisfy this limitation. It is not clear what is being claimed. The remaining claims are included since they stem from rejected claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 5, 6, 10-12, 19, 21, 26, 73-75, 78, 79-82, and 83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bradshaw (US 4,263,734) in view of Nalle, Jr. (US 2,984,035). Regarding claims 73-75, Bradshaw, as seen in Fig. 1-5, teaches a

Art Unit: 3727

background sheet 23 in the wall portion but not in the base portion. Nalle, Jr. teaches a similar container with a sheet 12 in between two layers of the bottom. It would have been obvious to employ the bottom sheet of Nalle, Jr. in the container of Bradshaw to provide the message that is visible after the user finishes the beverage as taught by Bradshaw. See Figs. 2, 3, and 4, where the modified container of Bradshaw has a completely transparent wall opposite the first region. This structure satisfies all the claim limitations. Regarding claim 4, see Figs. 5 and 8 of Bradshaw where the base portion, the wall portion and the interface region are integrally formed with each other. They are all attached or connected to each other. This satisfies the claim limitation. Regarding claims 12 and 83, see Fig. 2 of Nalle, Jr., where the background in the base portion of the modified container of Bradshaw covers approximately the entire bottom portion. Regarding claim 26, Bradshaw teaches the circular bottom and the generally cylindrical top but does not teach the generally conical lower part. Nalle, Jr., teaches a similar cup with a generally conical sidewall. It would have been obvious to make the sidewall generally conical to increase the volume of the cup. The generally conical sidewall satisfies the generally cylindrical limitation as well. The term generally is broad and allows for a great deal of variation. Claims 6, 10, 11, 19, 21, 79, 81, and 82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bradshaw in view of Nalle, Jr. in view of the admitted prior art. Regarding claims 6, 10, 11, 19, and 21, the examiner took the position of official notice in the previous office action that it is well known to employ specified color or a single hue. This position was not challenged or traversed by applicant. It is now admitted prior art. Claims 79, 81, and 82 are rejected

Art Unit: 3727

under the same admitted prior art. Regarding claims 5 and 78, as it is best understood, the protective layer is the inner layer as seen in Figs. 2 and 5 of Bradshaw.

Claims 2 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bradshaw in view of Nalle, Jr. as applied to claims 74 and 75 respectively above and further in view of Hultgren (US 3,338,458). Regarding claims 2 and 76, Nalle, Jr. does not teach the paint layer for the background. Hultgren teaches a similar decorated container with a decoration between two layers where the decoration can be printed on the inner surface of the outer layer. It would have been obvious to employ the printed decoration of Hultgren in the container of Nalle, Jr. to provide an alternative way to form the decoration. It would have been obvious to employ ink in the above printing since it is a proven way to accomplish the printing task. Moreover, ink is synonymous with printing. The ink has a layer and satisfies the limitation of the paint layer. There is no structural difference between the two.

Claims 7 and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bradshaw in view of Nalle, Jr. as applied to claims 74 and 75 respectively above, and further in view of Graham et al (US 3,912,100). Regarding claims 7 and 80, the modified container of Bradshaw teaches a background or sheet 23 that receives a picture, ornamentation, or a design but does not teach that the background or sheet 23 is opaque. Graham, et al as seen in Col. 4, teaches employing an opaque surface to provide a label or decorating panel. It would have been obvious to make the background sheet of Bradshaw opaque to make the picture or design stand out or to provide a greater visual impact.

Response to Arguments

Applicant's arguments with respect to claims 2, 4, 5, 6, 7, 10-12, 19, 21, 22, 26, 73-83 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kloges et al is cited for showing ink is used in printing.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

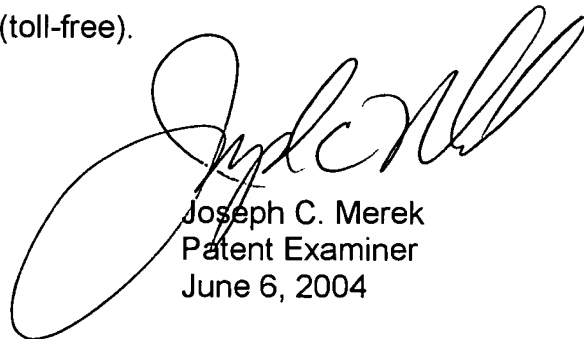
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 3727

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph C. Merek whose telephone number is (703) 305-0644. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee Young can be reached on (703) 308-2572. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Joseph C. Merek
Patent Examiner
June 6, 2004